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In re Application of FOX et al :
U.S. Application No.: 10/584,358 :
PCT Application No.: PCT/AU2004/001820 : DECISION
Int. Filing Date: 23 December 2004 :
Priority Date Claimed: 24 December 2003 :
Attorney Docket No.: 3276-7872US :
For: A SYSTEM FOR WATER TREATMENT :

This is in response to applicant's "Petition by Person Having Proprietary Interest to File Application on Behalf of Inventors Who Refuse to Sign or Cannot Be Found (37 C.F.R. § 1.47(b))" filed 02 March 2007.

BACKGROUND

On 23 December 2004, applicant filed international application PCT/AU2004/001820, which claimed priority of an earlier Australia application filed 24 December 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expired on 24 June 2006.

On 23 June 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 02 March 2007, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the

application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventors John Fox and Errol O'Brien refuse to sign the application papers. However, petitioner has not established that a bona fide attempt was made to present a copy of the application papers to Fox and O'Brien for signature. Furthermore, petitioner has not provided any specific details of the alleged refusal to sign. Thus, it would not be reasonable to conclude at the present time that the inventors refuse to join in the application.

With regard to item (3) above, the petition states the last known addresses of the nonsigning inventors.

With regard to item (4) above, the declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors is improper. Specifically, the declaration does not state the name of the person who executed the declaration.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or

(ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, petitioner has provided evidence of a chain of title from the inventors to Bushwater Holdings Pty Ltd. More specifically, petitioner has supplied copies of assignment agreements signed by the inventors granting title to the present invention to Bushwater Pty Ltd. and a copy of a license agreement by which Bushwater Pty Ltd. in turn assigned its rights to the present invention to Bushwater Holdings Pty Ltd.

With regard to item (6) above, an adequate statement with regard to the preservation of rights of the parties and/or the prevention of irreparable harm has been furnished.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136. Failure to respond in a timely manner will result in ABANDONMENT of the present application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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